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		Application Number	10/648,599
		Filing Date	August 25, 2003
		First Named Inventor	Bhavesh Mehta
		Art Unit	3622
		Examiner Name	Jeffrey D. Carlson
Total number of pages in this submission	9	Attorney Docket No.:	50269-0558

ENCLOSURES (Check all that apply)

- ☐ Fee Transmittal Form
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  - ☐ Affidavits/declaration(s)
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Printed Name	Christopher J. Brokaw		
Date	February 13, 2007	Reg. No.	45,620

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Client Ref.: Y00235US00

Docket No. 50269-0558 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	
Bhavesh Mehta et al.	:	Confirmation No.: 4272
Serial No.: 10/648,599	:	Group Art Unit: 3622
Filed: August 25, 2003	:	Examiner: Jeffrey D. Carlson
For: SELECTING AMONG ADVERTISEMENTS COMPETING FOR A SLOT ASSOCIATED WITH ELECTRONIC CONTENT DEVLIVERED OVER A NETWORK	:	

REPLY BRIEF UNDER 37 CFR § 1.193(b)(1)

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Sir:

This is in response to the Examiner's Answer mailed December 15, 2006, the shortened statutory period for which runs until February 15, 2007.

Client Ref.: Y00235US00

REMARKS

The Applicants respectfully submit to the Honorable Board that the claims are patentable over the cited art, and are in condition for allowance, for at least the reasons set forth in the Applicants' Appeal Brief. Without attempting to repeat or reiterate all the points of the Applicants' Appeal Brief, Applicants would like to refute certain points raised or relied upon in the Examiner's Answer in the present Reply Brief. For a more comprehensive explanation as to why the claims are patentable over the cited art, and are in condition for allowance, please refer to the Applicants' Appeal Brief.

Claims 1 and 3-10 set forth a useful result in conformance with 35 U.S.C. § 101

The Examiner's Answer summarizes the Applicants' position as being a "preparatory-based approach," and discusses this so-called preparatory-based approach with respect to an analogy involving reaching for a power switch to turn on a computer. To make his point using this analogy, the Examiner asserts, without any reasoning whatsoever, that **reaching for a power switch is not a useful act**.

Why is no support given for the assertion that it is not useful to reach for a power switch when one wants to turn on a computer? It can only be because such an assertion goes against all reason. Any grade-school child knows that a computer must be turned on before it can be used. What better way to turn a computer on than to actually reach for the power switch? When one wants to turn on a computer, reaching for a power switch is not only useful, in the absence of telekinetic powers or a clapper device, it is usually necessary.

It appears that the Examiner is confusing the other requirements for patentability, such as "novelty", with the utility requirement. While reaching for a power switch is indisputably useful, the act of reaching would not be patentable because computer users (with the possible exception of the Examiner) have been reaching for the power switches of their computers for decades.

The analogy presented by the Examiner poses a question that is more philosophical than legal. Specifically, every useful result is the consequence of an indeterminately-long series of actions. For example, one may reach for a computer

switch to turn on a computer to download a CAD program to design a motor to be used in a car that will eventually be built and used by a person to deliver pizzas to be eaten by customers. Certainly the consumption of food is a useful result. How far back into the causal chain does "useful" go? It is respectfully submitted that, as far as the utility requirement of 101 goes, all links in the chain of actions leading up to the useful result are useful.

Regardless of the power switch analogy, it is submitted that the usefulness of the express limitations of the claims must be considered based on the express limitations themselves, rather than deciding the issue on whether some other action (such as preparing to turn on a power switch) is useful or not.

The Examiner's Answer states:

> Because claim 1 does not necessarily require the instructions to be executed, the claim is not taken to positively set forth a useful result. Mere sending, receiving and/or storing of these instructions does not accomplish a useful result. (page 3)

The above statement is incorrect.

Transmitting executable code is useful to the recipient: Many businesses make their livelihood by selling software. Some customers of these businesses pay money for the right to download software. Certainly customers that are willing to pay for code to be transmitted to them believe that the transmission of the code to them is useful.

Purchased software may be delivered to a customer by the customer receiving the software over a network (such as the Internet), rather than the customer picking up the software from a physical department store. The customer often finds it useful to obtain his or her purchased software in this manner, e.g., the customer does not need to fight the rush hour traffic by driving to the store, and he or she may obtain the software faster by downloading the software than traveling out of his or her home to purchase the software from the store.

Storing executable code is useful to the recipient: Once the customer downloads the software using a machine, the software is stored on the machine. In this way, the software may be executed by the machine at the time of the user's choosing, which may be immediately, two weeks from now, or never. As the customer may execute

the software at his or her leisure once the software is stored, the customer finds storing instructions to be useful.

Transmitting executable code is useful to the sender: The business also finds it useful to sell its software in this manner because, by doing so, the business makes money. As a general rule, businesses find making money to be useful. In fact, the business may find making money in this manner to be particularly useful because the business need not operate any brick-and-mortar stores to sell software to customers, thereby minimizing the cost of operating their business. As a result, many businesses find it useful to send instructions.

The above discussion illustrates just how useful it is to receive, send, and store instructions that, when executed by one or more processors, cause the processors to perform a series of useful actions, such as the express limitations of the pending claims. As a result, it is respectfully submitted that the sending, receiving, and storing of machine-executable instructions must be a useful act, otherwise rational customers would not be willing to pay money to receive and store such instructions, and the business models of so many businesses would not be so reliant upon it.

Additional reasons illustrating why Claims 1 and 3-10 fully conform to 35 U.S.C. §101 are provided in the Applicants' Appeal Brief.

Claims 1 and 3-10 are patentable over *Carruthers*

The Examiner's Answer discusses *Carruthers* with respect to a "real-world example of seating at a concert/event." The Examiner's Answer states:

> In essence, Carruthers et al lets people into the venue first-come first served until the venue inventory/seating is at capacity. What Carruthers et al does not explicitly say is to also least partly rely on time of arrival (or time of ticket purchase) as a factor in determining how good of a seat you get, however given the preferential treatment at the door – would have been obvious to one of ordinary skill at the time of the invention to have also provided this preferential treatment as at least a partial basis for seat selection. (page 8-9)

Applicants respectfully disagree with the above assertion. Instead, by way of this metaphor, Applicants submit it would not have been obvious to have given preferential

treatment for seat selection once you are in the building based on when you bought your ticket because presumably you walked in the door into the building, and chose your seat, at the time of buying your ticket. In other words, you can perform preferential treatment either (a) at the door or (b) inside when assigning seats, but no one would be motivated to do both. This is so because the first person in the building can sit wherever he wants, the next person can sit in any vacant seat he wants, and so on. Simply put, it would be redundant to give preferential treatment at both (a) the door and (b) inside when assigning seats.

In the metaphor of the Examiner's Answer, *Carruthers* is analogous to providing preferential treating at the door, whereas the approach of the pending claims are analogous to providing preferential treating when assigning seats.

However, this metaphor is not yet an accurate comparison of the teaching of *Carruthers*. This is so because *Carruthers* employs a Capacity Forecaster 52 to determine whether to "let somebody in the door," so to speak. As taught by *Carruthers*, once a contract is accepted, the list of scheduled advertisements is based on the daily goals of meeting the requirements of the contract, and is not based on when the corresponding delivery obligation was incurred. As a result, to complete the metaphor, in *Carruthers*, anytime somebody walks through the door, everyone stands up and picks a new seat.

Carruthers present an alternate approach for achieving the goal of delivering advertisements in a fair manner, but not an approach that is suggestive of the express limitations of the pending claims. Because *Carruthers* provides a check to ensure fairness ***before*** accepting the terms of the contract (i.e., the functions performed by Capacity Forecaster 52), there is no motivation in *Carruthers* to perform the steps of Claim 1, which are directed towards providing a check to ensure fairness ***after*** the terms of the contract are accepted.

Carruthers discloses that the order in which advertisements should be sent to subscribers should be "based preferably both upon priority and some weighting mechanism that indicates how many impressions are needed by each campaign (paragraph 34, lines 8-10). Importantly, *Carruthers* makes clear that the order in which

advertisements are to be displayed is not based on when a delivery obligation was incurred. In sharp contrast, the prioritized master list of scheduled advertisements is based on the calculated goals of each of the active advertising campaigns (see paragraph 34). After the Inventory Manager of *Carruthers* generates the prioritized master list of scheduled advertisements based on the goals of each of the active advertising campaigns, the prioritized master list may be reordered based upon whether daily goals are met. For example, paragraph 35 of *Carruthers* states:

> The Delivery Manager 54 can **reorder or reprioritize** the master list of scheduled advertisements based upon delivery feedback data and queuing logic/algorithms. For example, if the goal for a given campaign is to evenly distribute an advertisement over the course of the campaign length, **the advertisements can be moved down in the queue of advertisements** to be displayed if it gets ahead of its daily goals. Similarly, if an advertisement gets behind in meeting its goals, **it may be automatically promoted in priority**. If an advertisement exceeds its daily goals **it can be effectively shut off by being placed at the very end of the queue**. (emphasis added)

Thus, if a particular advertisement is behind in its daily goals, it will be promoted in priority (see paragraph 54, underlined portion of quoted above) regardless of when the delivery obligation was incurred. As a result, *Carruthers* is an example of a most-behind-first approach, as discussed in the Applicants' background. Such an approach suffers from the same disadvantages discussed in Applicants' background.

Carruthers operates under the assumption that the contracted number and nature of impressions for an advertising campaign will actually be able to be delivered. As such, the features of Claim 1 are not performed. Indeed, since *Carruthers* does employ a Capacity Forecaster 52, there would be no need to maintain such a sequence for a plurality of advertisements, wherein the relative position of advertisements in the sequence corresponds to when the corresponding delivery obligation was incurred, since it has already been determined by Capacity Forecaster 52 that the proposed number and nature of impressions for an advertising campaign should be able to be delivered by the system of *Carruthers*.

Applicants respectfully disagree with the Examiner's continued assertion that the Applicants' claims do not solve the problems raised by in the Applicants' background

because the claims recite that selecting an advertisement to include in the slot is based, **at least in part**, on relative positions, within a sequence, that correspond to when the corresponding delivery obligation of the advertisement was incurred. Applicants point out to the Honorable Board that, because the selecting of an advertisement to include in the slot is based at least in part on the relative positions as claimed, the relative positions as claimed must be a factor, but it need not be the only factor. The Examiner's position appears to be that because it is not the sole factor, then the problems discussed in the Applicants background are not solved. However, the Examiner's position does not explain why this is so, nor does the Examiner cite any prior art that discusses selecting an advertisement to include in a slot as claimed based on that a consideration of a factor, wherein the factor is the relative positions, within a sequence, that correspond to when the corresponding delivery obligation of the advertisement was incurred.

The rejections under 35 U.S.C. § 103(a) lack the requisite factual and legal basis. *Carruthers* does not suggest numerous claimed limitations. Appellants respectfully submit that the imposed rejections under 35 U.S.C. § 103(a) are **not** viable and respectfully solicit the Honorable Board to **reverse** each of the imposed rejections under 35 U.S.C. § 103(a).

Respectfully submitted,
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on February 13, 2007 (Date) by Susan Jensen